



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/534,170	03/24/2000	Yoram Levanon	1268-094	2252

7590 09/20/2002

Lowe Hauptman Gopstein Gilman & Berner LLP  
Suite 310  
1700 Diagonal Road  
Alexandria, VA 22314

EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 09/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. 09/534,170	Applicant(s) Yoram LEVANON et al.
Examiner Stephen M. Gravini	Art Unit 3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on 8-29-02

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-8 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-8 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892)

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

6)  Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

1. Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed system does not recite a useful, concrete and tangible result under *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed Cir. 1998). The independently claimed steps of collecting information, analyzing and sorting profiles, producing advertisements, and presenting an appropriate advertisement are abstract ideas which can be performed mentally or naturally between persons without interaction of a physical structure. Collecting information is analogous to listening, analyzing and sorting profiles with producing advertisements is analogous to thinking of a response based on listening, and presenting an appropriate advertisement is analogous to responding to the listened data based on a thought response. Without a change in structure or manipulation of data, the independently claimed steps of collecting information, analyzing and sorting profiles, producing advertisements, and presenting an appropriate advertisement do not produce a useful, concrete and tangible result. The independently claimed steps of collecting information, analyzing and sorting profiles, producing advertisements, and presenting an appropriate advertisement and claims depending from them, are not permitted under 35 USC 101 because it is non-statutory subject matter. Since claims 2-7 depend upon claim 1, directly or indirectly, those claims are also rejected as depending

Art Unit: 3622

upon a claim containing non-statutory subject matter. However in order to consider those claims in light of the prior art, examiner will assume that those claims recited statutorily permitted subject matter.

***Claim Rejections - 35 USC § 112***

2. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 7 recites the broad recitation between three and thirty seven clusters and between people, and the claim also recites corresponding to all possible combinations and especially useful for dating services etc. respectively which is the narrower statement of the range/limitation.

Art Unit: 3622

3. Claim 7 is rejected under 35 USC 112, second paragraph as being indefinite for containing a broad recitation followed by a narrower recitation. In order to consider those claims in light of the prior art, examiner will assume that those claims contain non-indefinite subject matter.

***Claim Rejections - 35 USC § 102***

4. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Day et al. (US 5,857,175) or Weinblatt (US 5,515,270) and are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kramer et al. (US 6,327,574) or Eldering (US 6,298,348) and are rejected under 35 U.S.C. 102(g) as being clearly anticipated by Lanzillo, jr. et al. (US 2002/0032602) or McKinley et al. (US 2002/0044743).

***Claim Rejections - 35 USC § 103***

5. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weinblatt et al. (US 5,515,270). Weinblatt teaches the claimed invention, including the steps of collecting information, analyzing and sorting profiles, producing advertisements, and presenting an appropriate advertisement, on the face of the patent. Weinblatt does not expressly show the analyzing and sorting of profiles into the clusters of survival, growth, and relaxation. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The analyzing and sorting steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention

Art Unit: 3622

from the prior art in terms of patentability, see *In re Gulack*, 32 F. 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to analyze and sort profiles having any type of content, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

#### *Response to Arguments*

6. Applicant's arguments filed August 29, 2002 have been fully considered but they are not persuasive.

#### *non-statutory subject matter rejection*

Applicants argue that the claimed invention falls into either one or both of the safe harbors outlined for computer related inventions. However, a process is statutory if it requires physical acts (emphasis added) to be performed outside the computer independent of and following the steps to be performed by a programmed computer, where those acts involve the manipulation of tangible physical objects and result in the object having a different physical attribute or structure.

*Diamond v. Diehr*, 450 U.S. at 187, 209 USPQ at 8. Also, another statutory process is one that requires the measurements of physical objects or activities (emphasis added) to be transformed outside of the computer into computer data (*In re Gelnovatch*, 595 F.2d 32, 41 n.7, 201 USPQ 136, 145 n.7 (CCPA 1979) (data-gathering step did not measure physical phenomenon); *Arrhythmia Research Tech. v. Corazonix Corp.*, 958 F.2d at 1056, 22 USPQ2d at 1036), where

Art Unit: 3622

the data comprises signals corresponding to physical objects or activities external to the computer system, and where the process causes a physical transformation of the signals which are intangible representations of the physical objects or activities. *In re Schrader*, 22 F.3d at 294, 30 USPQ2d at 1459 citing with approval *Arrhythmia*, 958 F.2d at 1058-59, 22 USPQ2d at 1037-38; *In re Abele*, 684 F.2d at 909, 214 USPQ at 688; *In re Taner*, 681 F.2d 787, 790, 214 USPQ 678, 681 (CCPA 1982). Finally, there is always some form of physical transformation within a computer because a computer acts on signals and transforms them during its operation and changes the state of its components during the execution of a process. Even though such a physical transformation occurs within a computer, such activity is not determinative of whether the process is statutory because such transformation alone does not distinguish a statutory computer process from a nonstatutory computer process. What is determinative is not how the computer performs the process, but what the computer does to achieve a practical application. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. A process that merely manipulates an abstract idea or performs a purely mathematical algorithm is nonstatutory despite the fact that it might inherently have some usefulness (emphasis added). *In re Sarkar*, 588 F.2d at 1335, 200 USPQ at 139. In this application, the independently claimed invention does not fall within any of the safe harbors argued by the applicants. First, the independently claimed collecting emotional information is not a physical act because an emotion is not a tangible physical object that can be manipulated such that a different physical attribute or structure results. Second, emotional orientation is not a physical object or activity, but rather an intangible mental condition, and therefore cannot be

Art Unit: 3622

transformed outside of the computer into computer data. Finally, a cluster corresponding to a character profile is an abstract idea since the character profile cluster is based on an abstract emotion and manipulation of that abstract idea is nonstatutory despite the fact that it might inherently have some usefulness.

*anticipatory rejections*

Applicants argue the claimed invention is not anticipated over the cited references because those references do not discuss individual emotional orientations including survival, growth, and/or relaxation. The face of the Day reference discusses “customer purchasing behavior.” Customers purchase goods and/or services for nourishment (survival and/or growth) or recreation (relaxation). The face of the Weinblatt reference discusses “consumer purchasing behavior.” Consumers purchase goods and/or services for nourishment (survival and/or growth) or recreation (relaxation). The face of the Kramer reference discusses “consumer profile attributes based on personal information reflecting online and offline transactions.” Consumer profiles are indicative of the claimed individual emotional orientations because online and offline transactions will reflect information necessary for survival, growth, and/or relaxation. The face of the Eldering reference discusses “consumer profiling containing demographic data and product preferences.” Consumer profiling is indicative of the claimed individual emotional orientations because demographic data and product preferences will reflect information necessary for survival, growth, and/or relaxation. The face of the Lanzillo reference discusses “user demographic processing.”

Art Unit: 3622

User demographics are indicative of the claimed individual emotional orientations because demographic data will reflect information necessary for survival, growth, and/or relaxation. The face of the McKinley reference discusses “consumer lifestyle and profile activities for commerce assistance.” Consumer lifestyle and profile are indicative of the claimed individual emotional orientations because lifestyle and profile will reflect information necessary for survival, growth, and/or relaxation. Since each of those references implicitly discuss individual emotional orientations including survival, growth, and/or relaxation, each reference anticipates the claimed invention by performing the same function in the same manner with the same result.

*obviousness rejection*

Applicants assert that individual emotional orientation is not nonfunctional descriptive material since it is not the same as music, literature, art, photographs and mere arrangements or compilations of facts or data. The independently claimed information collected based on individual emotional orientation is a compilation of data. That information is not manipulated, changed, or interacted with any structure within the claimed invention such that it would be not be an obvious variation of the invention patented by Weinblatt.

*Conclusion*

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3622

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicants choose to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-3600 are:

After-final	(703) 872-9327
Official	(703) 872-9326
Non-Official/Draft	(703) 872-9325

*Steve Gravini*  
**STEPHEN GRAVINI**  
**PRIMARY EXAMINER**

smg

September 19, 2002